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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/679,294	10/06/2000	Masaaki Usui	107531	8349

25944 7590 08/11/2005

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EXAMINER
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KARMIS, STEFANOS

ART UNIT	PAPER NUMBER
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3624

DATE MAILED: 08/11/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/679,294

Applicant(s)

USUI, MASA AKI

Examiner

Stefano Karmis

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 18 May 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,3 and 5 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3 and 5 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

### **DETAILED ACTION**

1. The following communication is in response to Applicant's amendment filed 18 May 2005.

#### ***Status of Claims***

2. Claims 1 and 3 are currently amended. Claim 5 is previously presented. Claims 2, 4, 6 and 7 are previously cancelled. Therefore claims 1, 3 and 5 are currently pending.

#### ***Response to Arguments***

3. Applicant's arguments with respect to claims 1, 3 and 5 have been considered but are moot in view of the new ground(s) of rejection.

#### ***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:  
  
The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
5. Claims 1, 3 and 5 are rejected under 35 U.S.C. 112, second paragraph, as failing to set forth the subject matter which applicant(s) regard as their invention..

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Regarding claim 1, the phrase "and/or" makes it unclear whether all the elements are required or only one. The Examiner interprets the phrase using the "or" meaning. Therefore for claim 1, the said financial institution server making a determination as to whether or not a request is from said client computer based on an Internet Protocol (IP) address and/or authentication information from said client computer requires that only an IP address **or** authentication information be present, and not both. Therefore the claim is rendered indefinite because it is unclear whether the limitation(s) following the phrase are part of the claimed invention. See MPEP 2173.05(d). Claim 3 contains a similar phrase as claim 1 and therefore is rejected with the same reasoning. Claim 5 is rejected based upon its dependency.

### ***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

8. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.

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2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

9. Claims 1, 3 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Motoyama U.S. Patent 5,913,202 in view of Lewis et al. (hereinafter Lewis) U.S. Patent 6,233,565.

Claims 1, 3 and 5 were rejected under 35 U.S.C. 102(e) as being unpatentable over Motoyama U.S. Patent 5,913,202 as stated in the previous office action, mailed 23 February 2005. Regarding claim 1, Motoyama teaches that a client at a computer enters a command to initiate a service request and the financial delivery computer executes an initial process including user authentication, and then begins the service transaction (column 8, lines 24-32). Motoyama fails to specify that the said authentication is based on an Internet Protocol (IP) address and/or authentication information from said client computer. Lewis teaches a system and method for conducting Internet based financial transactions in which transactions serves exist on a unique IP address to authenticate and direct transactions (column 8, lines 8-37 and column 11, lines 46-57). Therefore it would have been obvious to one of ordinary skill in the art at the time of the Applicant's invention to modify the authentication teachings of Motoyama and include that the authentication be based on an Internet Protocol (IP) address and/or authentication information from said client computer because it provides detail to the steps that Motoyama teaches for authentication when a client at a computer enters a command to initiate a service request and the financial delivery system authorizes that request. Claim 3 contains a similar phrase as claim 1

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and therefore is rejected with the same reasoning. Claim 5 is rejected based upon its dependency.

*Conclusion*

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stefano Karmis whose telephone number is (571) 272-6744. The examiner can normally be reached on M-F: 8-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on (571) 272-6747. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Respectfully Submitted, **VINCENT MILLIN**  
Stefano Karmis **SUPERVISORY PATENT EXAMINER**  
05 August 2005 **TECHNOLOGY CENTER 3600**

